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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,626	09/26/2005	Taichi Sawaguchi	053165	5423
38834 7590 07/09/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
ARNBERG, MEGAN C				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/550,626

Applicant(s)

SAWAGUCHI, TAICHI

Examiner

MEGAN ARNBERG

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukada et al. (WO 01/92412, using US 6,953,819 as an English language translation) when taken with the instant specification.

Regarding claims 1-4, 6 and 7: Tsukada et al. teaches a resin composition containing an alicyclic polymer (col. 3 lines 17), and the hindered amine polymer poly[{6-(1,1,3,3-tetramethylbutyl)amino-1,2,3-triazine-2,4-diyl} {(2,2,6,6-tetramethyl-4-piperidyl)imino}hexamethylene {(2,2,6,6-tetramethyl-4-piperidyl)imino}] (col. 16 lines 20-22). Tsukada et al. teaches the hindered amine polymer is incorporated within the range of 0.01-20 parts by weight per 100 parts by weight of the alicyclic polymer (col. 16 lines 44-46). Tsukada et al. teaches the hindered amine has a molecular weight between the range of 2000-5000 (col. 15 lines 45-53). Since this hindered amine polymer is identical to the chemical name of that cited claimed in claim 3, the light transmittance property is inherent. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911

F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01 (II). It is evidenced by the admitted prior art in paragraph 71 of the Pre-Grant Publication of the instant application that purity is related to the light transmittance. However, since no specific purity is claimed, the exact chemical structure of the hindered amine compound of Tsukada et al. meets the instant claims. Further it is admitted in paragraph 72 of the Pre-Grant Publication of the instant application that there is commercially available the exact hindered amine with a light transmittance of 95%, which meets the limitation of 90% or more of the instant claim 1.

Tsukada et al. teaches a transparent molded article (col. 19 lines 59-64 and col. 20 lines 18) and being capable of being used with a device with a blue laser is an inherent property of the molded article.

Regarding claim 5: Tsukada et al. teaches an additional polymer added to the composition in a range of 0.1-10 parts by weight of the alicyclic polymer (col. 18 lines 5-25). Tsukada et al. is silent on residual metal content of the additional polymer. The Office recognizes that all of the claimed effects and physical properties are not positively stated by the reference. Note however, that the reference teaches all of the claimed ingredients, process steps and process conditions and thus, the claimed effects and physical properties would inherently be achieved by carrying out the disclosed process. If it is the applicant's position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure in that there is no

teach as to how to obtain the claimed properties and effects by carrying out only these steps.

Claims 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukada et al. (WO 01/92412, using US 6,953,819 as an English language translation) when taken with the instant specification.

Regarding claims 8-12: Tsukada et al. teaches a resin composition containing an alicyclic polymer (col. 3 lines 17), and the hindered amine polymer poly[6-(1,1,3,3-tetramethylbutyl)amino-1,2,3-triazine-2,4-diyl] {(2,2,6,6-tetramethyl-4-piperidyl)imino}hexamethylene {(2,2,6,6-tetramethyl-4-piperidyl)imino} (col. 16 lines 20-22). Tsukada et al. teaches the hindered amine has a molecular weight between the range of 2000-5000 (col. 15 lines 45-53). Since this hindered amine polymer is identical to the chemical name of that cited claimed in claim 3, the light transmittance property and the lack of clouding property is inherent. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01 (II). It is evidenced by the admitted prior art in paragraph 71 of the Pre-Grant Publication of the instant application that purity is related to the light transmittance. However, since no specific purity is claimed, the exact chemical structure of the hindered amine compound of Tsukada et al. meets the instant claims. Further it is

admitted in paragraph 72 of the Pre-Grant Publication of the instant application that there is commercially available the exact hindered amine with a light transmittance of 95%, which meets the limitation of 90% or more of the instant claim 1.

Tsukada et al. teaches a transparent molded article (col. 19 lines 59-64 and col. 20 lines 18) and being capable of being used with a device with a blue laser is an inherent property of the molded article.

Response to Arguments

Applicant's arguments filed March 28, 2008 have been fully considered but they are not persuasive. Applicant's arguments have been addressed in the above rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEGAN ARNBERG whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO, PhD./
Supervisory Patent Examiner, Art Unit 1796
5-Jul-08

/M. A./
Examiner, Art Unit 1796